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P.S.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/959,125 10/28/97 HIGUCHI

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EXAMINER

ALEXANDER, L

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 02/09/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/959,125

Applicant(s)
Higuchi et al.

Examiner
Lyle A. Alexander

Group Art Unit
1743



☒ Responsive to communication(s) filed on Dec 16, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-5 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claim Rejections - 35 USC § 112

1. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification does not exclude the use of chemical bonding of the beads.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Koyama et al., Terahima or Ep 162,302.

See the appropriate paragraph of paper 9 for the teachings of Koyama et al.

Response to Arguments

4. Applicant's arguments filed 12/16/99 have been fully considered but they are not persuasive.

With respect to the limitation of “ wherein the beads are not chemically bonded to each other ... “ this has not been considered in light of the new matter issues above. However, Koyama et al. teaches in columns 2-3 that it is known to embed particles in a single layer but is

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disadvantageous for the reasons of void volumes and "clogging" of the structure. The court has decided In re Boe (148 USPQ 507) that use of a non-preferred embodiment is within the skill of the art. If Applicants can show support in the original disclosure for the language deemed as new matter, the Office will apply *Koyama et al.* in a 35 USC 103 rejection as reasoned here.

With respect to the limitation of "comprising a single reagent layer", this language is open and does not exclude additional layer. If the language --consisting of a single reagent layer-- where used, the appropriate 35 USC 102 rejections would be overcome in favor of 35 USC 103 rejections.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is (703) 308-3893.

LAA

February 8, 2000



LYLE A. ALEXANDER
PRIMARY EXAMINER